

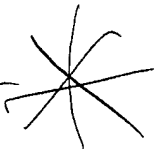
AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/980,712
Attorney Docket No. Q67023

REMARKS

Claims 1-17 are all the claims pending in the application.

I. Preliminary Matters

The Examiner indicates that an Information Disclosure Statement filed on October 7, 2002, fails to comply with 37 C.F.R. § 1.98(a)(1), since a form PTO-1449 was not provided with a list of all patents, publication, or other information submitted for the Examiner to consider (see Office Action, page 2). Applicants note, however, that an Information Disclosure Statement has not been filed in this case. Since this is a 37 C.F.R. § 371 National Stage Application, Applicants believe that the Examiner is referring to the international search report. As such, Applicants note that, in accordance with MPEP 1893.03(e), the Examiner “will consider the documents cited in the international search report, without any further action by applicant under 37 C.F.R. § 1.97 and 1.98, when the international search report and copies of the documents are indicated to be present in the national stage file. The Examiner will note the consideration in the first Office Action.”



In the present application, copies of the documents cited in the International search were made available to the Examiner in the national stage application on December 5, 2001, as indicated in the Notice of Acceptance of Application under 35 U.S.C. § 371 and 37 C.F.R. § 1.494 or 1.495. Therefore, an Information Disclosure Statement, including PTO-1449, is not necessary in this case and the cited documents should have been considered by the Examiner in the first Office Action. Accordingly, Applicants request the Examiner to indicate that each of

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/980,712
Attorney Docket No. Q67023

the documents, which were cited in the international search report, has been considered, in the next Patent Office correspondence. Applicants note that the Examiner already has considered at least JP 09-169383, JP 149872, and Hehn et al., since these references have been applied to the claims of the application, in the present non-final Office Action.

II. Indefiniteness Rejections

The Examiner rejects claims 1-4 under 35 U.S.C. § 112, second paragraph. The Examiner alleges that the phrase “bottom plate” in claim 1, line 18, should be replaced with --said cover plate--. However, Applicants amend claim 1 to replace the phrase “bottom plate” with the phrase --said cover plate-- at line 20 of claim 1, not line 18. Accordingly, Applicants request the Examiner to withdraw the § 112 rejection of claims 1-4.

Additionally, Applicants amend the claims to correct minor grammatical errors and to make editorial changes to conform with U.S. patent practice. These amendments are not believed to change the scope of the claims.

III. Anticipation Rejections

A. Claims 1 and 3:

The Examiner rejects claims 1 and 3 under 35 U.S.C. § 102(b) as being anticipated by JP 09-169383 (hereinafter, JP ‘383). For at least the following reasons, Applicants respectfully disagree with the Examiner’s position, and therefore, traverse this rejection.

Applicants' invention relates to a novel and unobvious combination of elements that form a storage case for storing a magnetic tape cassette. For example, with reference to the exemplary embodiment depicted in Fig. 1, the storage case comprises a storage part 120 that is openably and closably connected to a cover part 130 through a hinge part 112. The storage part 120 comprises a bottom plate 121 and inner walls 122. On the other hand, the cover part 130 comprises a cover plate 131 and outer walls 132. Additionally, in this exemplary embodiment of the present invention, at least one pair of ribs 124 is provided on at least one of: (1) the neighboring portions of the connecting portions between the bottom plate 121 and the inner walls 122 of the storage part 120, and (2) the neighboring portions of the connecting portions between the cover plate 131 and the outer walls 132 of the cover part 130. The ribs 124 define a predetermined clearance capable of storing an information sheet between the back surface 111b or front surface 111a of the magnetic tape cassette 111 and the bottom plate 121 of the storage part 120, or the cover plate 131 of the cover part 130.

In particular, independent claim 1 recites, *inter alia*, that at least one pair of ribs is provided "on at least one of the neighboring portions of the connecting portions between said bottom plate and said inner walls of said storage part and the neighboring portions of the connecting portions between said cover plate and said outer walls of said cover part".

The Examiner takes the position that Fig. 6 of JP '383 discloses all of the recitations of independent claim 1, including at least one pair of ribs (52) disposed on the neighboring portions of the connecting portions between the cover plate and the outer walls for storing an information

sheet, which the Examiner compares to the “ribs”, as recited in claim 1. Applicants respectfully submit that the Examiner is mischaracterizing JP ‘383.

Contrary to the Examiner’s position, JP ‘383 neither discloses nor suggests that the ribs (52) are provided “on at least one of the neighboring portions of the connecting portions between said bottom plate and said inner walls of said storage part and the neighboring portions of the connecting portions between said cover plate and said outer walls of said cover part”, as recited in claim 1. Instead, JP ‘383 discloses two pairs of stops 52 for holding a restricted piece 51 which are disposed in the central portion 43a of the case 43, not on the neighboring portions of the connecting portions of the plate and the walls. Therefore, for at least the foregoing reasons, Applicants submit that JP ‘383 clearly does not anticipate independent claim 1. Accordingly, Applicants request the Examiner to withdraw the § 102(b) of claim 1 (and dependent claim 3).

B. Claims 9-11 and 16:

Additionally, the Examiner rejects claims 9-11 and 16 under 35 U.S.C. § 102(b) as being anticipated by Weisburn (U.S. Patent No. 5,597,068). For at least the following reasons, Applicants traverse this rejection.

As set forth above, Applicants’ invention relates to a novel and unobvious combination of elements that form a storage case for storing a magnetic tape cassette. For example, with reference to the exemplary embodiment depicted in Fig. 12, the storage case comprises a storage part 311 that is openably and closably connected to a cover part 312 through a hinge part 314.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/980,712
Attorney Docket No. Q67023

The storage part 311 comprises a bottom plate 121 and inner walls 122. One or more ribs 315a, 315b having mutually opposed surfaces is disposed on the hinge part 314.

In particular, independent claim 9 recites, *inter alia*, that “the dimension of said hinge part is set such that, when said cover part is closed while said magnetic tape cassette is stored, between said cover part and said magnetic tape cassette, there can be defined a clearance capable of storing a sheet bundle therein; and, in the range of said clearance and on said hinge part, there are disposed one or more ribs each including mutually opposed surfaces.”

The Examiner takes that position that Weisburn discloses one or more ribs (40-43, 46, and 47) that are inherently capable of storing a magnetic tape cassette and holding an information sheet therein. For at least the following reasons, Applicants respectfully disagree with the Examiner’s position.

Weisburn discloses that the container may be used to store other articles, such as video tapes, audio tapes or video game cartridges, when the holder 55 and jewel box 70 are removed from panel 12. Thus, since the holder 55 must be removed to enable the storage case of Weisburn to hold other articles, Applicants submit that Weisburn clearly does not disclose that the dimension of the hinge part is set such that there can be defined a clearance capable of storing a sheet bundle between the cover part and the magnetic tape cassette, nor that one or more ribs are disposed in the range of the clearance and on said hinge part. In other words, Applicants submit that Weisburn does not disclose that the ribs are disposed on the hinge part such that a tape cassette can be held between the ribs and the cover part, and additionally, such

that the ribs could be used to hold an information sheet between the cover part and the tape cassette. On the contrary, Weisburn discloses that the holder 55 must be removed from the ribs 40-43 (i.e., outwardly extending receptacles) to provide space for other articles, including tape cassettes.

Therefore, for at least the foregoing reasons, Applicants submit that the claimed invention is not inherently disclosed by Weisburn, as alleged by the Examiner. Accordingly, Applicants request the Examiner to withdraw the § 102(b) of claim 9 (and dependent claims 10, 11, and 16).

IV. Obviousness Rejections

A. Claims 1, 3, and 4:

The Examiner rejects claims 1, 3, and 4 under 35 U.S.C. § 103(a) as being obvious over JP '383 and JP 149872 (hereinafter, "JP '872").

Independent claim 1 recites, inter alia, that "said ribs define, between the back surface or front surface of said magnetic tape cassette and said bottom plate of said storage part or said cover plate of said cover part, a predetermined clearance capable of storing an information sheet therein." For example, as shown in the exemplary embodiment of Figure 2, the ribs 124 define a clearance between the tape cassette 111 and the bottom plate 121, such that the information 113 can be contained therein.

The Examiner alleges that JP '383 discloses all of the features of claim 1, except for a "pair" of ribs, as recited in claim 1. Therefore, the Examiner looks to JP '872 for the disclosure

of a pair of ribs and alleges that it would have been obvious to combine JP '383 and JP '872 to arrive at the claimed invention.

As set forth above, JP '383 discloses two pairs of stops 52 for holding a restricted piece 51. The stops 52 are disposed in the central portion 43a of the case 43, not on the neighboring portions of the connecting portions of the plate and the walls.

On the other hand, JP '872 discloses a pair of ribs 12 that are disposed on the surface of the outer walls of the cover part 11 on the neighboring portions of the connecting portions between the bottom plate and the walls (see Fig. 4). In Figure 4 of JP '872, the ribs 12 are depicted as supporting the information sheet 17. However, as shown in Figure 3, the ribs 12 engage the outer surface of the inner walls of the storage part 14 when the storage case is in the closed position. That is, the ribs 12 engage the projections 15 to lock the case in the closed position. As such, the ribs 12 do not define a clearance between the tape cassette and the storage part or cover part, as recited in claim 1. On the contrary, as shown in Figure 3, the inner walls 14a of the storage part 14 are interposed between the ribs 12, which are formed on the outer walls of the cover part, and the tape cassette 18. As such, the tape cassette 18 is free to contact directly the information sheet 17. Thus, the ribs 12 do not, and cannot, define a clearance between the tape cassette and the storage part or the cover part, as recited in claim 1.

Therefore, for at least the foregoing reasons, Applicants submit that JP '872 clearly does not make up for the deficiencies of JP '383. That is, Applicants submit that any device resulting from the combination of JP '383 and JP '872 would not disclose or suggest all of the recitations

of independent claim 1. As such, Applicants submit that claims 1, 3, and 4 would not have been obvious over any combination of JP '383 and JP '872.

B. Claim 2:

The Examiner rejects claim 2 under 35 U.S.C. § 103(a) as being obvious over JP '383, JP '872, and Mallery (U.S. Patent No. 5,697,497). In particular, the Examiner concedes that JP '383 fails to disclose that the ribs are disposed substantially over the entire area of the connecting portions, as recited in claim 2. However, the Examiner alleges that it would have been obvious to modify JP '383 in view of Mallery to arrive at the claimed combination. That is, the Examiner takes the position that it would have been obvious to modify JP '383 to include the flanges 116 and 118 of Mallery. For at least the following reasons, Applicants traverse this rejection.

As set forth above, JP '383 discloses two pairs of stops 52 for holding a restricted piece 51, which are disposed in the central portion 43a of the case 43, not on the neighboring portions of the connecting portions of the plate and the walls.

Additionally, JP '872 discloses a pair of ribs 12 that are disposed on the surface of the outer walls of the cover part 11 on the neighboring portions of the connecting portions between the bottom plate and the walls (see Fig. 4). However, as shown in Figure 3, the ribs 12 engage the outer surface of the inner walls of the storage part 14 when the storage case is in the closed position. As such, the ribs 12 do not define a clearance between the tape cassette and the storage part or cover part, as recited in independent claim 1. Thus, the ribs 12 do not, and cannot, define

a clearance between the tape cassette and the storage part or the cover part, as recited in independent claim 1.

On the other hand, Mallery discloses slot flanges 116 and 118 that extend along most of the length of the side edges 112 and 114 to form continuous slots for receiving a booklet (see Fig. 2). That is, the booklet is inserted in the slots formed by the edges 120 and 122 of the flanges 116 and 118 (see col. 4, lines 10-23). However, Mallery does not disclose or suggest that the slot flanges 116 and 118 define a clearance between the compact disc and the information sheets. In fact, Mallery does not disclose or suggest that the slot flanges support the compact disc. Instead, as shown by Mallery, the compact disc is supported by a central art on the storage portion 104. Thus, the slot flanges 116 and 188 of Mallery also do not, and cannot, define a clearance between the compact disc, or a tape cassette, and the storage part or the cover part, as recited in independent claim 1. As such, Mallery does not make up for the deficiencies of JP '383 and JP '872.

In comparison, independent claim 1 recites, inter alia, that "said ribs define, between the back surface or front surface of said magnetic tape cassette and said bottom plate of said storage part or said cover plate of said cover part, a predetermined clearance capable of storing an information sheet therein." Applicants submit that any combination of JP '383, JP '872, and Mallery would not have disclosed or suggested all of the recitations of claim 1, from which claim 2 depends. As such, Applicants submit that claim 2 clearly would not have been obvious from any combination of JP '383, JP '872, and Mallery, and therefore, requests the Examiner to withdraw this rejection.

C. Claims 5-8:

The Examiner rejects claims 5-8 under 35 U 103(a) as being obvious over JP '383, JP '872, Mallery, and Hehn et al. (U.S. Patent No. 4,643,301). Applicants note that Hehn was not included in the overall rejection of claims 2, and 5-8; however, Hehn is cited in the text of the rejection of claim 5 (see Office Action, page 4, numbered paragraph 6).

To make up for the deficiencies of JP '383, JP '872, and Mallery, the Examiner looks to Hehn for the disclosure of a back cover of a booklet that engages a video cassette storage case. In particular, the Examiner takes the position that the back cover of Hehn is equivalent to "a sheet-shaped member", as recited in independent claim 5. For at least the following reasons, Applicants respectfully disagree with the Examiner's position.

As set forth above, the present invention relates to a novel and unobvious combination of elements that form a storage case for storing a magnetic tape cassette. In particular, claim 5 recites, *inter alia*, "a pair of ribs" that "project inwardly of said cover part." Additionally, claim 5 recites, *inter alia*, "a sheet-shaped member disposed substantially parallel to said cover plate of said cover part with a given distance between them, said sheet-shaped member having two end portions that are fixed to said ribs, said sheet-shaped member defining, between said cover plate of said cover part and itself, a predetermined clearance capable of storing an information sheet therein."

For example, in the illustrative, non-limiting embodiment shown in Figure 8, the storage case comprises a pair of ribs 234 that project inwardly of the cover part 230. A sheet-shaped

member 235 is disposed substantially parallel to the cover plate 231 of the cover part 230 with a given distance between the sheet-shaped member 235 and the cover plate 231. Additionally, the sheet-shaped member 235 has two end portions that are fixed to the ribs 234, such that the sheet-shaped member 235 defines, between the cover plate 231 of the cover part 230 and the sheet-shaped member 235, a predetermined clearance capable of storing an information sheet 213 therein.

In comparison, Hehn discloses a booklet pocket for a video cassette storage container. In particular, Hehn discloses a pocket forming panel 2 that can be removeably mounted on the outside of the end wall 5 of the storage container 3, or alternatively, to the outside of the lid 12, to form a pocket therebetween (see, e.g., Figs. 1-3, 5, 7, and 8 of Hehn). That is, Hehn merely discloses a pocket forming panel 2 that can be attached to the outside of a cassette storage case. Thus, since the pocket forming panel 2 of Hehn is mounted on the outside of the cassette storage case, Hehn does not, and cannot, disclose or suggest at least the claimed “pair of ribs that project inwardly of the cover part”, as recited in independent claim 5. To this end, Hehn also does not, and cannot, disclose or suggest a sheet-shaped member having two end portions that are fixed to ribs that project inwardly of the cover part, as recited in claim 5.

For at least these reasons, Applicants submit that Hehn does not make up for the deficiencies of JP ‘383 or JP ‘872. Therefore, Applicants submit that independent 5 (and dependent claims 6-8) would not have been obvious over any combination of the applied references.

Furthermore, Applicants submit that dependent claims 6-8 independently and separately are patentable over the applied references, at least by virtue of the additional recitations recited therein. For example, claim 6 recites, *inter alia*, that the “ribs are respectively structured in such a shape that, when said magnetic tape cassette is stored, said ribs are operable to press against said magnetic tape cassette to said storage part side.” However, the externally mounted pocket forming panel 2 of Hehn does not even contact the tape cassette, which is enclosed inside the video cassette storage case 3. Therefore, Hehn also clearly does not disclose or suggest at least ribs that are structured in such a shape that, when the tape cassette is stored, the ribs are operable to press against the tape cassette, as recited in claim 6.

For at least the foregoing reasons, Applicants submit that claims 5-8 would not have been obvious over any combination of the applied references. Accordingly, Applicants request the Examiner to withdraw the § 103(a) rejection of claims 5-8.

D. Claims 9-17:

The Examiner rejects claims 9-17 under 35 U.S.C. § 103(a) as being obvious over Weisburn. Applicants respectfully disagree with the Examiner’s position, and therefore, traverse the rejection of these claims.

The Examiner takes the position that Weisburn discloses all of the recitations of independent claim 9. However, as set forth above, Weisburn discloses that the container may be used to store other articles, such as video tapes, audio tapes or video game cartridges, when the holder 55 and jewel box 70 are removed from panel 12. Thus, since the holder 55 must be

removed to enable the storage case of Weisburn to hold other articles, Applicants submit that Weisburn clearly does not disclose that the dimension of the hinge part is set such that there can be defined a clearance capable of storing a sheet bundle between the cover part and the magnetic tape cassette, nor that one or more ribs are disposed in the range of the clearance and on said hinge part, as recited in claim 9.

To establish a *prima facie* case of obviousness, the Examiner must show that Weisburn, or the prior art in general, suggests modifying the dimension of the hinge part of Weisburn, such that there can be defined a clearance capable of storing a sheet bundle between the cover part and a magnetic tape cassette, and that one or more ribs are disposed in the range of the clearance and on the hinge part, as recited in independent claim 9. However, Applicants respectfully submit that the Examiner has not set forth this or any other motivation for modifying Weisburn to arrive at the claimed combination of elements. Thus, the Examiner has not established a *prima facie* case of obviousness with respect to at least independent claim 9. Accordingly, Applicants submit that the obviousness rejection of claim 9 (and dependent claims 10-17) should be withdrawn. Furthermore, Applicants submit that dependent claims 10-17 separately and independently are patentable over Weisburn at least by virtue of the additional recitations recited therein.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

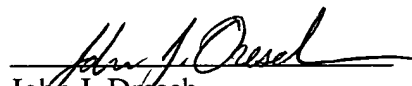
AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/980,712
Attorney Docket No. Q67023

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860


John J. Driesch
Registration No. 46,672

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: April 21, 2003